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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/606,967      | 06/27/2003  | Katsuro Saito        | 826.1463C           | 4837             |

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

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| EXAMINER |
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BORLINGHAUS, JASON M

|          |              |
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| ART UNIT | PAPER NUMBER |
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3693

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                      |              |  |
|------------------------------|----------------------|--------------|--|
| <b>Office Action Summary</b> | Application No.      | Applicant(s) |  |
|                              | 10/606,967           | SAITO ET AL. |  |
|                              | Examiner             | Art Unit     |  |
|                              | Jason M. Borlinghaus | 3693         |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/27/03, 1/4/06 and 3/30/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/27/03, 1/4/06, 3/30/06</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 12 and 14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claim 1 of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

Claim 13 is rejected under 35 U.S.C. 101 as claiming the same invention as that of Claim 6 of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

Claim 15 is rejected under 35 U.S.C. 101 as claiming the same invention as that of Claim 3 of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

Claims 16 - 21 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 5 - 10, respectively, of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

Claim 22 is rejected under 35 U.S.C. 101 as claiming the same invention as that of Claim 12 of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

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Claims 24 – 27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 17 – 20, respectively, of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

Claims 28 - 30 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 21 - 23, respectively, of prior U.S. Patent No. 6,669,832. This is a double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language contained within said cited prior art reference while unquoted language contained within

parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as “reading on” or being “mapped to” the claim language prior to such parenthetical inclusions.

**Claims 12 – 23 and 28 – 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art (applicant's specification, p. 1, line 10 – p. 2, line 24) in view of Pooler (Pooler, Victor H. & Pooler, David J. *Purchasing and Supply Management: Creating the Vision*. Springer. January 1, 1997. pp. 76 – 81) and Hough (Hough, Harry E. *Purchasing for Manufacturing*. Industrial Press Inc. 1996. pp. 14 – 29, 51 – 53 and 128).

**Regarding Claims 12 - 15**, Disclosed Prior Art discloses a transaction system for making an estimate request and an order request, an article or service required by an organization to a vendor outside the organization (see p. 1, lines 11 – 16) comprising:

- a processing unit installed inside the organization (“general affairs office in the organization”) and having input means for inputting a request (“sent to the general affairs office”) in order to exhibit the request to a plurality of vendors outside of the organization (“sends requests to each vendor”) and inputting information related to the request on the basis of information sent from the vendor after the request has been made (“estimate request...is sent in writing to the requesting general affairs office”), the information related to the request being generated (“order request”) and exhibited to the vendor. (see pp. 1 – 2);

- a management unit (“general affairs office”) for managing communications (estimate request, order request, estimate reply and bill transmission) between the processing unit (“general affairs office”) in the organization and a processing unit (office) in the vendor company, the management unit including:
- information entry means installed inside the organization for entering data input by the input means of the processing unit in the organization. (“requests for estimates and orders...sent to the general affairs office in the organization” – see p. 1);
- transmission means for transmitting the request entered into the information entry means installed in the organization (“general affairs office...sends the requests to each vendor”) and request-related data input later as requested by the processing unit in the vendor company (“a reply is sent in writing to the requesting general affairs office”). (see pp. 1 – 2); and
- entry means installed outside the organization for transmitting data used by the vendor to make a reply to the request as requested by the processing unit in the vendor company (“a reply is sent in writing to the requesting general affairs office”). (see pp. 1 – 2); and
- entering data input and sent by the processing unit in the vendor company. (“a reply is sent in writing to the requesting general affairs office”). (see pp. 1 – 2).

Disclosed Prior Art does not teach underlined limitations - an electronic transaction system for making an estimate request and an order request, an article or service required by an organization to a vendor outside the organization comprising:

- a processing unit installed inside the organization and having input means for inputting a request in order to exhibit the request to a plurality of vendors outside of the organization and inputting information related to the request on the basis of information sent from the vendor after the request has been made, the information related to the request being generated and exhibited to the vendor after examining whether the information sent from the vendor meets requirements of the organization for purchasing articles or services which the vendor supplies;
- if, when an order request for an article or service is sent to the vendor, and an estimate reply has not been obtained from the vendor, a request to estimate the article or service is made to the vendor before the order request is sent and the order request is then sent after a reply to the estimate request has been received; and
- when replies to the estimate request are obtained from two or more vendors, the order request is automatically made to a vendor that fulfills predetermined evaluation criteria.

Disclosed Prior Art does not teach that the system is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a

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mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Furthermore, automated systems for management and transmission of information ("Electronic Data Interchange") between an organization ("buyer") and a vendor ("seller") are old and well known in the art of information technology and supply chain management, as evidenced by Hough (see pp. 21 – 22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art through automation of the manual system and incorporation of conventional components to make such automated possible, as disclosed by Hough, to increase inter-communication between transaction parties, to increase speed of communication between such parties and/or to reduce paperwork and paper file management.

Additionally, automation of a manual process would necessitate the incorporation of components and elements in order to achieve such automation. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have utilized conventional and/or standard technology at the time that the invention was made to automate the above disclosed method and/or system.

Conditioning the submission of an order request after examination of the estimate ("bid analysis" – see pp. 19 – 21) and vendor requirements ("supplier certification" – see pp. 52 – 53), requesting an estimate before submission of an order ("a good buyer will ask a number of questions before placing the order" – see p. 14), receipt of estimates ("bids") from two or more vendors, determination and/or provision of



delivery statement for an accepted order ("form is returned to user with...the scheduled delivery date." – see p. 23) are old and well known in the art of supply chain management and purchasing management, as evidenced by Hough. It would have been obvious to one of ordinary skill in the art to have modified Disclosed Prior Art and Hough by incorporating such activities, methodologies and practices that are conventional and/or standard in the art of supply chain management and purchasing management, as evidenced by Hough.

Submission of order requests to a vendor that fulfills predetermined evaluation criteria ("[q]ualification of suppliers is based on a satisfactory assessment of selected criteria" – see p. 81 and "Buyer's Checklist for Selecting New Suppliers" – see pp. 78 – 80) is old and well known in the art of supply chain management and purchasing management, as evidenced by Pooler. It would have been obvious to one of ordinary skill in the art to have modified Disclosed Prior Art and Hough by incorporating such activities, methodologies and practices that are conventional and/or standard in the art of supply chain management and purchasing management, as evidenced by Pooler.

Requesting an estimate on a product and/or service before submission of an order for a product and/or service, and submission of an order for a product and/or service after the estimate for the product and/or service has been received is old and well known in the art of supply chain management and purchasing management. For example, a consumer traditionally asks for an estimate – asking a mechanic how much a car repair will cost, asking a salesman how much a computer costs, asking a tailor how much alterations will cost – before committing to the purchase. It would have been

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obvious to one of ordinary skill in the art to have modified Disclosed Prior Art, Hough and Pooler by incorporating such activities, methodologies and practices that are conventional and/or standard in the art of supply chain management and purchasing management.

**Regarding Claim 16**, Disclosed Prior Art discloses a transaction system for making a request, which is one of an estimate request and an order request, for ordering articles or services required by an organization to vendors outside the organization (see p. 1, lines 11 – 16) comprising:

- first processing units installed in department offices of the organization (“an enterprise department office”) for inputting the request (inputted, “approved by superior officer in the office and sent to the general affairs office”) and a second processing unit installed inside the organization (“general affairs office”) for managing the request made by the first processing units (“department office”). (see p. 1, line 11 – p. 2, line 8) wherein:
  - the second processing unit (“general affairs office”) including management means (“sorts out the requests and sends the requests to each vendor”) for managing dates of delivery of articles or services (“term of delivery”) input from processing units installed in the vendor companies (“reply is sent ... to the requesting general affairs office”). (see p. 1, line 11 – p. 2, line 8); and

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- acceptance inspection of an article or service delivered (“delivered articles or services are sometimes not inspected for a long time in an organization, delaying payment to vendors”). (see p. 2, lines 19 – 24).

Disclosed Prior Art does not teach the underlined limitations – an electronic transaction system for making a request, which is one of an estimate request and an order request, for ordering articles or services required by an organization to vendors outside the organization comprising;

- the second processing unit including management means for managing dates of delivery of articles or services input from processing units installed in the vendor companies and acceptance processing means for determining, for each first processing unit that makes a new request, the presence or absence of order requests made by that first processing unit for which acceptance inspection of an article or service delivered has not been made within a predetermined period of time after its date of delivery and refusing the new request when the acceptance inspection has not been made.

Disclosed Prior Art does not teach that the system is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Furthermore, automated systems for management and transmission of information ("Electronic Data Interchange") between an organization ("buyer") and a vendor ("seller") are old and well known in the art of information technology and supply chain management, as evidenced by Hough (see pp. 21 – 22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Disclosed Prior Art through automation of the manual system and incorporation of conventional components to make such automated possible, as disclosed by Hough, to increase inter-communication between transaction parties, to increase speed of communication between such parties and/or to reduce paperwork and paper file management.

Additionally, automation of a manual process would necessitate the incorporation of components and elements in order to achieve such automation. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have utilized conventional and/or standard technology at the time that the invention was made to automate the above disclosed method and/or system.

Withholding future orders and/or purchases from a supplier until the delivered items and/or completed orders can be inspected, certified and/or qualified by the buyer, and setting a predetermined timeframe for such a process is old and well known in the art of supply chain management and purchasing management. For example, a consumer traditionally evaluates and inspects delivered merchandise before submitting additional orders to the same supplier, to ensure that the consumer is not tying up financial resources in continuously purchasing unsatisfactory merchandise. It would

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have been obvious to one of ordinary skill in the art to have modified Disclosed Prior Art, Hough and Pooler by incorporating such activities, methodologies and practices that are conventional and/or standard in the art of supply chain management and purchasing management.

**Regarding Claims 17 – 18**, Claims 17 - 18 recite similar limitations and/or would have been obvious based upon Claims 12 – 15 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 12 – 15.

**Regarding Claim 19**, Claim 19 recites similar limitations and/or would have been obvious based upon Claim 15 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claim 15.

**Regarding Claims 20 - 21**, Claims 20 - 21 recite similar limitations and/or would have been obvious based upon Claim 12 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claim 12.

**Regarding Claims 22 - 23**, Claims 22 - 23 recite similar limitations and/or would have been obvious based upon Claim 12 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claim 12.

**Claims 24 - 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Disclosed Prior Art, Pooler and Hough, and in further view of OECD (*ICCP Reviews of Information and Communications Policies. Organization for Economic Co-operation and Development*. November 19, 1992. p. 83).

**Regarding Claims 24 - 27**, Claims 24 - 27 recite similar limitations and/or would have been obvious based upon Claim 12 - 16 rejected above, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 12 - 16.

Differing claim limitation(s) of Claims 24 – 27 concerning communication through a Value Added Network (VAN) is old and well known in the art of information technology, as evidenced by OECD (see p. 83). It would have been obvious to one with ordinary skill in the art at the time the invention was made to have utilized conventional and/or standard technology at the time that the invention was made to automate the above disclosed method and/or system.

### ***Conclusion***

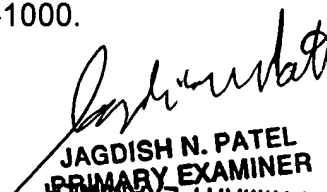
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached ay (571) 272 - 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JAGDISH N. PATEL  
PRIMARY EXAMINER  
JAGDISH N. PATEL  
PRIMARY EXAMINER

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